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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/657,910

09/09/2003

Kenichi Chiba

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5169

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

05/21/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

It is noted that applicants have filed an Amendment after the Final Rejection on 5/07/09; applicants' attorney has addressed the issues of record. The proposed amendment will be not entered because the amendment raises a new issue that would require further consideration and /or search ; thus , it is not in a condition for allowance.

### **The Status of Claims**

Claims 1-24,27-31,33,36,38-40,42-43,46-60,62-63,65-67 are pending.

Claims 1-24,27-31,33,62-63, and 65-67 are objected.

Claims 36, 38-40,42-43,46-60 are withdrawn from consideration.

### **Claim Objections**

In claims 1 , 2 , 14, and their corresponding dependent claims, the phrase “

Y is  $\text{CHR}_{17}$ ,  $\text{C=O}$ , or  $\text{CR}_{17}$ ; and Z is  $\text{CHR}_{18}$ ,  $\text{C=O}$ , or  $\text{CR}_{18}$ .” is recited. The variables Y and Z contain not only a carbon group, but also a carbonyl group; the carbonyl group does not belong to the Group IV; therefore, it must be removed from the claims.

### **New Issue**

In the proposed amendment, claims 71-72, 84, and their corresponding dependent claims, the variables Y and Z contain not only a carbon group, but a carbonyl group; the carbonyl group

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does not belong to the Group IV. This raises a new issue that would require further consideration and /or search.

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The rejection of Claims 1-24,27-31,33,62-63, and 65-67 provisionally on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22,40,43,66, and 81 of copending Application No. 10/507,067 has been withdrawn due to filing the Terminal Disclaimer on 5/07/09.

### **Applicants' Argument**

1. Applicants argue the following issues:
  - i. Applicants request for rejoinder of withdrawn claims 46-60 and 95-109 because Group IV is drawn to a pharmaceutical composition wherein X is oxygen, Y and Z are carbon

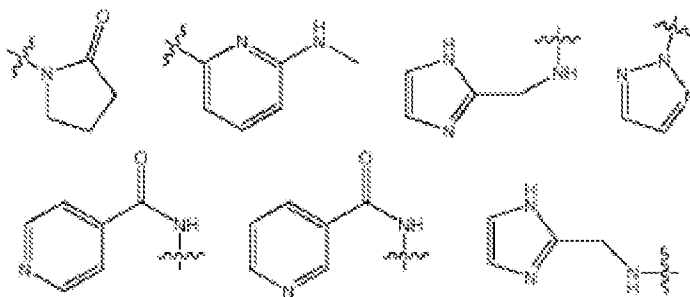
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and those claims are directed to a single, inventive concept so that they would not present a search burden.

Applicants' arguments have been noted, but the arguments are not found to be persuasive.

Regarding the applicants' argument, the Examiner has noted applicants' argument. However, in claims 1, 2, 14, 46-60, 71-72, 84, 95-109 and their corresponding dependent claims, the variables Y and Z contain not only a carbon group, but also a carbonyl group; the carbonyl group does not belong to the Group IV; furthermore, particularly claim 105 (withdrawn-new) does contain the substituent R<sub>9</sub>, which has the following species:

morpholine, imidazole, aminopyridine, or any one of:



In view of these groups, searching each group presents a lot of burdens for the examiner; also, unlike applicants remarks, there is no a single and inventive concept among them. Therefore, it is improper to consider rejoining the withdrawn claims 46-60 and 95-109 to the current claims at this time. It would be better to cancel the withdrawn claims and any new claims related to the withdrawn claims in order to expedite the application.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Taylor Victor Oh, MSD,LAC  
Primary Examiner  
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/Taylor Victor Oh/

Primary Examiner, Art Unit 1625

5/19/09

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